

REMARKS

In the Office Action, claims 1-28 were rejected. By the present Response, claim 14 is amended. Upon entry of the amendments, claims 1-28 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

Claim 14 was rejected under 35 U.S.C. §112, second paragraph. By the present Response, claim 14 has been amended to correct an inadvertent typographical error. The correction is believed to obviate the basis for the rejection. Reconsideration is requested.

In the Office Action, claims 1-7 were rejected under 35 U.S.C. §102(e) as being anticipated by Foo et al. (U.S. Patent No. 6,198,283). Claims 8-15 and 16-28 were also rejected, but with no clear basis set forth in the formulation of the rejections, certain references being made to "suggested" and "made obvious" in the rejections. By a brief telephone conference held with the undersigned on September 19, 2001, Examiner Chen indicated that these rejections also were intended to be formulated under 35 U.S.C. §102(e).

All pending claims are believed to be clearly allowable over the Foo et al. reference as that reference is unavailable as prior art or, in alternative, is not enabling as of the effective date of the reference. In particular, the present application was filed on December 31, 1998. The Foo et al. reference was filed on December 27, 1999. Thus, the filing date of the Foo et al. reference is after the filing date of the present application. Although the Foo et al. reference indicates that it is a continuation-in-part of application serial no. 09/154,673, filed on September 18, 1998, the contents of that earlier application are not believed to be properly included in any rejection of the present application.

As clearly set forth in MPEP §2136.03, the use of a continuation-in-part patent as prior art requires that the U.S. patent reference must (a) have a right of priority to the earliest date under 35 U.S.C. §120, and (b) support the invention claimed in the reference as required by 35 U.S.C. §112, first paragraph. "For if a patent could not theoretically had issued the day the application was filed, it is not entitled to be used against another as 'secret prior art'" under 35 U.S.C. §102(e). See, *In re Wertheim*, 209 U.S.P.Q. 554, 564 (CCPA 1981).

In the case of the Foo et al. reference, all independent claims include a reference to either a network for communication of certain data to a remote facility, or to such communicating of data to a remote facility. The subject matter claimed was enabled as of the date of the filing of the continuation-in-part, that is, December 27, 1999. Accordingly, the reference is unavailable as prior art under 35 U.S.C. §102(e). All claims are therefore believed to be clearly allowable over Foo et al., and their reconsideration is requested.


Conclusion

In view of the above remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the drawings and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

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Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please amend the claim as follows:

- 1 14. (Amended) The system of claim 12, wherein the predefined service
2 functions include functions specific to computed ~~tomology~~ tomography imaging system